

REMARKS

Claim 17 is cancelled. Claim 8 is amended. No new subject matter is added.

Allowable Subject Matter

Claims 1-7, 18, and 19 are allowed.

Claim 17 is objected to as being dependent upon a rejected base claim, but is otherwise indicated to be allowable if rewritten in independent form to include all the features of its base claim (claim 8). In keeping with this suggestion, claim 8 is amended to incorporate the subject matter of claim 17. Claim 17 is cancelled.

Claim Rejections, 35 USC § 112

Claims 8-17 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, with regard to claim 8, it is alleged that the specification "does not describe the third current, but only describes the circuit as having two current sources. It is not clear what applicant considers a third current, since the laser only receives an Ibias or an Ibias + Imod." The applicants disagree.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. MPEP 2163(I). It is well accepted that a satisfactory description may be *in the claims or any other portion of the originally filed specification*. MPEP 2163(I), emphasis added.

It is alleged that what the applicant considers the third current is not clear, since the circuit is described as only having two current sources. In rebuttal, the applicant notes that claim 8 recites first, second, and third *amounts* of current, it does not recite three current sources (emphasis added).

Original claim 8 recited first and second current sources capable of generating first and second amounts of current, respectively. The specification (page 3, lines 7-9 and FIG. 1) further specifies that the "second current source 145 [is] capable of generating an amount of current equal to modulation current and bias current." Thus, one of ordinary skill would understand that the recited second amount of current is composed of the modulation current plus the bias current.

Original claim 8 recited that the circuit is capable of delivering the second amount of current to a device. As the applicant explains on page 4, lines 1-2, "modulation plus bias

current" may pass through the VCSEL diode." As noted above, the second amount of current was defined as the modulation current plus the bias current.

Original claim 8 also recited that the circuit is capable of delivering "an amount of current substantially equal to the second amount of current less the first amount of current" to the device. As the applicant explains on page 3, lines 26-27, "*bias current* may be passing through the VCSEL diode 240" (emphasis added). One of skill in the art can easily subtract the recited first amount of current (I_{mod}) from the recited second amount of current ($I_{mod} + I_{bias}$) to see that the result is I_{bias} .

Earlier in the prosecution of this application, claim 8 was rejected under 35 USC 112, second paragraph, as being indefinite because the recited "an amount of current" was allegedly not accompanied by a corresponding structure for generating the current. The applicant's comments in regard to this rejection are repeated below:

Regarding claims 8-17 and 20, the Examiner rejects claim 8 because it recites "an amount of current" without reciting a corresponding structure for generating a "current substantially equal to a second amount of current." However, the recited "an amount of current" is actually fully defined as "an amount of current substantially equal to the second amount of current less the first amount of current." Thus, the recited "amount of current" is defined in terms of the recited first and second amounts of current that are provided by a recited first and second current source, respectively. One of ordinary skill armed with a knowledge of Kirchoff's Current Law would understand how a recited "amount of current" that is "substantially equal to the second amount of current less the first amount of current" may be supplied to a device using the claimed circuit.

The rejection of claim 8 under 35 USC 112, second paragraph, was subsequently withdrawn.

Later, for clarity, claim 8 was amended so that the recited "an amount of current" became "third amount of current." This was felt to be more consistent with the previously recited "first amount of current" and "second amount of current." The applicant notes that the recited "third amount of current," exactly like the "an amount of current" that came before it, is still defined, in the claim itself, as being "substantially equal to the second amount of current less the first amount of current."

Thus, by changing the previously recited "an amount of current" to "third amount of current", the applicant allegedly runs afoul of the written description requirement. To the contrary, there is no *in haec verba* requirement for newly added claim limitations. MPEP 2163(I)(B). That is, there is no requirement that the features of the claim must be recited in

exactly the same words that are used in the specification. However, the features must be supported in the specification by express, implicit, or inherent disclosure. MPEP 2163(I)(B).

The applicant submits, due to the express disclosure identified above in the original specification, an adequate written description exists for the recited "third amount of current substantially equal to the second amount of current less the first amount of current."

Claim Rejections, 35 USC § 102

Claims 8-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,709,370 to Bednarz et al. ("Bednarz").


Claim 8 is amended to incorporate the subject matter of claim 17, which was previously indicated to contain allowable subject matter. Claim 17 is cancelled. Claims 8-16 and 20 should thus be in condition for allowance.

Conclusion

For the above reasons, reconsideration and allowance of claims 8-16 and 20 is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.


Todd J. Iverson
Reg. No. 53,057

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613
Customer No. 20575

I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office via facsimile number (703) 872-9306, on 6 June 2005.

Signed:


Judy Wignore